REMARKS

The 35 USC 101 Rejection of Claims 1-9.

The Office Action rejected claims 1-9 under 35 U.S.C. 101 as being directed to non-statutory subject matter. The applicants respectfully traverse this rejection based on the arguments below.

If a claimed mathematical algorithm or computer program produces a "useful, concrete, and tangible result" it cannot be rejected on the grounds of being non-statutory under 35 U.S.C. 101. AT&T Corp. v. Excel Communications, Inc., Docket No. 98-1338, (Fed. Cir. April 14, 1999). State Street Bank & Trust Co. v. Signature Financial Group, Inc., 149 F. 3d 1368 (Fed. Cir. 1998). The applicants' claims include comparing a buyer's profile and the inferred criteria with the criteria of the products or services offered by agents to match a suitable agent with a suitable buyer based on the created profile of the buyer in a computer system that produces a **practical application** within the technological arts to find a prospective buyer and providing the identity of the buyer to agents. Therefore, the Applicants' invention includes a well-established practical application that satisfies the requirement of 35 USC 101. State Street Bank & Trust Co. v. Signature Financial Group, Inc., 149 F. 3d 1368 (Fed. Cir. 1998). Arrythmia Research Technology Inc. v. Corazonix Corp., 958 F.2d 1053, 22 USPQ2d 1033 (Fed. Cir. 1992). MPEP 706.03 et seq.

Furthermore, the USPTO's own guide on software related patent applications (Examination Guidelines for Computer-Related Inventions Final Version) available on its website, states,

"A process that consists solely of the manipulation of an abstract idea without

9

any limitation to a practical application is non-statutory.[1] **Office personnel have the burden to establish a *prima facie* case that the claimed invention taken as a whole is directed to the manipulation of abstract ideas without a practical application....**In order to determine whether the claim is limited to a practical application of an abstract idea, **Office personnel must analyze the claim as a whole, in light of the specification, to understand what subject matter is being manipulated and how it is being manipulated. During this procedure, Office personnel must evaluate any statements of intended use or field of use, any data gathering step and any post-manipulation activity.** *See* section IV.B.2(d) above for how to treat various types of claim language. **Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under § 101. Further, when such a rejection is made, Office personnel must expressly state how the language of the claims has been interpreted to support the rejection."**

Clearly, when viewing the claim as a whole, Claim 1 is not devoid of any limitation in a practical application in the technological arts. The applicants' claims include comparing a buyer's profile and the inferred criteria with the criteria of the products or services offered by agents to match a suitable agent with a suitable buyer based on the created profile of the buyer in a computer system that produces a **practical application** within the technological arts to find a prospective buyer and providing the identity of the buyer to agents.

Furthermore, the Examiner cites that "For example in claim 1, the invention in the body of the claim does not recite the use nor incorporate any technology in carrying out the recited method steps and therefore is not necessary." As per the USPTO own guidelines on the examination of software-related inventions, in order to determine whether the claim is limited to a practical application of an abstract idea, **Office**

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[1] *E.g., Warmerdam,* 33 F.3d at 1360, 31 USPQ2d at 1759. *See also Schrader,* 22 F.3d at 295, 30 USPQ2d at 1459.

personnel must analyze the claim as a whole, in light of the specification, to understand what subject matter is being manipulated and how it is being manipulated. ...**Only when the claim is devoid of any limitation to a practical application in the technological arts should it be rejected under § 101. Further, when such a rejection is made, Office personnel must expressly state how the language of the claims has been interpreted to support the rejection."** Clearly, as discussed above, comparing a buyer's profile and the inferred criteria with the criteria of the products or services offered by agents **to match a suitable agent with a suitable buyer based on the created profile of the buyer** is a practical application. Clearly, Claim 1 does not meet the USPTO's own definition of what is non-statutory subject matter:

> "In practical terms, claims define non-statutory processes if they:
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> - consist solely of mathematical operations without some claimed practical application (*i.e.*, executing a "mathematical algorithm"); or
>
> - simply manipulate abstract ideas, *e.g.*, a bid[2] or a bubble hierarchy,[3] without some claimed practical application."

Therefore, the Applicants' invention includes a well-established practical application that satisfies the requirement of 35 USC 101. It is therefore respectfully requested that the rejection of 1-9 under 35 USC 101 be reconsidered based on the foregoing arguments.

The 35 USC 103 Rejection of Claims 1-27.

Claims 1-27 were rejected under 35 USC 103(a) as being unpatentable over Raveis, Jr., U.S. Patent No. 6,321,202, in view of Burge, U.S. Patent No. 6,014,638, in

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[2] *Schrader*, 22 F.3d at 293-94, 30 USPQ2d at 1458-59.

[3] *Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759.

11

further view of Mini, U.S. Patent No. 6,014,638. The Examiner contended that it would have been obvious to combine Raveis with the system and method of Burge to enable the ability for the computer implemented method and system to create a profile of the buyer by inferring criteria desired by the buyer based on the buyer's interaction with the interactive environment and to compare the profile and the inferred criteria to the products and services offered by agents to match a suitable agent with a suitable buyer based on a created profile of the buyer. However, the Examiner further contended that the Raveis and Burge combination does not specifically disclose providing the identity of the suitable buyer to the agent, but that Mini does. The applicants respectfully traverse this contention of obviousness.

The applicants' claimed invention encompasses a system and method for finding a prospective buyer and providing the buyer to agents offering for sale products or services. The applicant's claimed invention provides the buyer with an interactive environment having information relating to the products or services offered by the agents. A profile of the buyer is created by inferring criteria desired by the buyer based on the buyer's interaction with the interactive environment. The profile and the inferred criteria are compared with the criteria of the products or services offered by the agents to match a suitable agent with a suitable buyer based on the created profile of the buyer. **The identity of the suitable buyer is provided to the suitable agent.**

Mini teaches methods and apparatus are described for facilitating a transaction corresponding to real property between a seller and a buyer via a network. A negotiation relating to the real property between the buyer and the seller is facilitated via the network. Access by at least one of the buyer and the seller via the network to a plurality of real estate services is provided. Each of the plurality of real estate services relates to an aspect of the transaction, and each of the plurality of real estate services is necessary for the transaction to progress. (See abstract.) **Mini also does not teach providing the identity of a suitable buyer to an agent. Rather Mini provides the**

12

identity of an agent to a buyer and allows the buyer to select the agent. There is no targeting of the buyer by the agent in Mini.

Granted, the Examiner states that Col. 8, lines 48-55 teaches providing the identity of the suitable buyer to the suitable agent. This passage is included in the following.

"A more detailed embodiment of buyer process 120 will now be described with reference to the process flow diagram of FIGS. 10-21. Initially and as described above, a potential buyer would visit the web site, browse through the various informational pages, possibly run the buyers demo, e.g., demo 106 of FIG. 1, and select the "Get Started Now!" text in any of several pages in the web site (block 1002). ...The buyer may then decide to continue with the process or wait for a call from a customer service agent associated with the web site (block 1008). If the buyer elects to wait for the call, an e-mail message is sent to a customer service agent (block 1010) who then calls the buyer to answer any questions the buyer might have (block 1012). **If the buyer decides to continue, she makes a deposit with, for example, a credit card, browses through the real estate professional bios, and selects a "virtual agent" (block 1014).** This information is processed (block 1006), and reviewed and filtered by a customer service agent (block 1018), after which the buyer and **the selected virtual agent** connect by, for example, phone or an online audio or video conference (blocks 1020 and 1022) during which the buyer and the agent get to know each other and the agent describes the buying process including the next steps to be completed."

Clearly, **Mini provides the identity of an agent to a buyer and allows the buyer to select the agent. Mini does not provide the identity of the buyer to the seller for purposes of the seller targeting the buyer.**

Raveis teaches a system and method for managing real estate transactions. The method includes the steps of receiving and storing data relating to a plurality of contacts including buyers and sellers of real estate, receiving and storing data relating to a plurality of vendors each associated with at least one phase of a real estate transaction, accessing vendor data based upon occurrence of a particular phase of the real estate transaction and communicating data relating to the vendors to a contact upon occurrence of the particular phase of the real estate transaction. As stated by the Examiner, Raveis, does not, however, disclose and teach a computer-implemented method and system which creates a profile of the buyer by inferring criteria desired by the buyer based on the buyer's interaction with the interactive environment and compares a buyer's profile and inferred criteria with the criteria of the products or services offered by the agents to match a suitable agent with a suitable buyer based on the created profile of the buyer. **Nor does Raveis teach providing the identity of the suitable buyer to the suitable agent.**

Burge teaches a system for customizing content and presentation of content for computer users is disclosed. The system monitors and records a user's navigational choices to determine the user's needs and preferences for subsequent computer displays. Displays are customized in accordance with the user's needs and preferences. In a preferred embodiment of the present invention, an electronic marketing and shopping system accessible via the WWW is described. The shopping environment--including the opportunities presented to the shopper (content) and the appearance of the displays (presentation of content)--is customized according to the shopper's preferences. The functions of data collection and display customization are performed automatically by the electronic shopping system. To customize the environment, various attributes of Web pages or other displays provided by participating merchants are modified as they are accessed by shoppers using the system. (Abstract) **Burge does not, however, provide the identity of a suitable buyer to a suitable agent. Burge merely displays certain items to the buyer based on the buyer's past preferences. No seller's criteria is used to match a buyer to a seller and**

14

provide the seller the buyer's identity. In Burge it is impossible for the seller to obtain the buyer's identity.

In order to deem the applicants' claimed invention unpatentable under 35 USC 103, a prima facie showing of obviousness must be made. To make a prima facie showing of obviousness, all of the claimed elements of an applicant's invention must be considered, especially when they are missing from the prior art. If a claimed element is not taught in the prior art and has advantages not appreciated by the prior art, then no prima facie case of obviousness exists. The Federal Circuit court has stated that it was error not to distinguish claims over a combination of prior art references where a material limitation in the claimed system and its purpose was not taught therein (*In Re Fine*, 837 F.2d 107, 5 USPQ2d 1596 (Fed. Cir. 1988)).

In view of the lack of a prima facie case of obviousness, the remaining rejected Claims 1-27 cannot be deemed to be unpatentable under 35 USC 103 over Burge and Raveis in view of Mini. As such, it is respectfully requested that the rejection of Claims 1-27 be reconsidered based on the following claim language, as exemplified by Claim 1:

" A computer implemented method for finding a prospective buyer and providing the identity of the buyer to agents offering for sale at least one of products or services, the method comprising using a computer to perform the following process actions...providing the buyer with an interactive environment having information relating to the products or services offered by the agents; creating a profile of the buyer by inferring criteria desired by the buyer based on the buyer's interaction with the interactive environment; comparing the profile and the inferred criteria with criteria of the products or services offered by the agents to match a suitable agent with a suitable buyer based on the created profile of the buyer; **and providing the identity of the suitable buyer to the suitable agent.**"

Furthermore, it is the applicants' position that there is no motivation to modify the Raveis or Burge teachings with those of Mini because such a combination would destroy the stated function of the Burge invention. Burge teaches a system for customizing content and presentation of content for computer users. The system monitors and records a user's navigational choices to determine the user's needs and preferences for subsequent computer displays. The functions of data collection and display customization are **performed automatically** by the electronic shopping system. Most transactions cited in this passage in Mini are not automated but are conducted via email messages and phone calls, and even require a buyer to make a deposit, browse through real estate bios and to select a virtual agent. Therefore, in order to combine Mini with Burge the automated function of the Burge invention would be destroyed by the substitution of manual actions required by Mini for matching a buyer to seller. Furthermore, in Mini the buyer selects the agent and not vice versa.

It is well settled in the law that a 35 USC 103 rejection based on a modification of prior art that destroys the function of the invention disclosed in the prior art, is improper and does not establish a prima facie case of obviousness. *In Re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). There is simply no technological motivation for a worker to make such a detrimental modification. To the contrary, a significant disincentive exists. In this case, the proposed substitution of Mini's providing the identity of the buyer to a perspective agent would destroy the functionality of the Raveis and Burge inventions and so a prima facie case of obviousness cannot be established from the cited references.

In view of the lack of a prima facie case of obviousness, the remaining rejected Claims 1-27 cannot be deemed to be unpatentable under 35 USC 103 over Burge and Raveis in view of Mini. As such, it is respectfully requested that the rejection of Claims 1-27 be reconsidered based on the above quoted claim language.

Summary.

In summary, it is believed that the claims are in condition for allowance. Reconsideration of the rejection of Claims 1-27 is respectfully requested. Allowance of these claims at an early date is also courteously solicited.

Respectfully submitted,
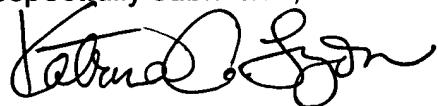
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17